

REMARKS/ARGUMENTS

Status of Claims

The Office Action mailed December 16, 2004 has been reviewed and carefully considered. Claims 1-7 have been canceled and new claims 8-14 have been added, with claim 8 being the only independent claim. Reconsideration of the above-identified application, in view of the revised set of claims and the following remarks, is respectfully requested.

Overview of the Office Action

Claims 1-7 have been objected to because of various informalities. Claims 1-7 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,547,225 to DeAngelis (hereinafter "DeAngelis") in view of U.S. Patent No. 5,447,566 to Loiacono (hereinafter "Loiacono").

Amendments addressing informalities

Applicant has replaced claims 1-7 with claims 8-14. Claims 8-14 are "definite and positively recite structure" as required by the Examiner. Moreover, such claims are believed to comply with all applicable requirements.

Summary of Details Disclosed in the Specification

The following details are based on the specification and are provided only for the convenience of the Examiner as part of the discussion presented herein. Such details are not intended to argue limitations which are unclaimed.

Conventional rotary presses are known to have a problem that an undried printed paper surface may come into contact with a guide roller causing ink to adhere to the guide roller. That ink can then transfer back to a paper surface, thereby contaminating the printed paper. See paragraph [0003]. Conventional ink transfer preventing measures cannot eliminate ink transferred onto the guide roller surface completely and hence require the guide roller to be washed periodically, they are costly, and/or have other shortcomings. See paragraph [0005].

The disclosed embodiments of the present invention provide a rotary press capable of preventing a printing color from contaminating any color different from it. This is accomplished, according to one aspect of the present invention, with a rotary press having a printing unit made of a set of printing cylinders, a dryer disposed downstream of the printing unit for drying printed paper, a guide roller for guiding the printed paper from the printing unit into the dryer, and a drive unit that drives the guide roller. The guide roller has a diameter which is equal to, or an integral multiple of, a diameter of the printing cylinder in the printing unit. Also, the guide roller is driven to rotate synchronously with the printing cylinder and at a peripheral speed that is identical to that at which the printing cylinder is rotated. In this way, the guide roller is always contacted by an identical portion of an image printed onto the paper, and this prevents print on the paper from being contaminated with any color other than a printing color.

Patentability of the Claim 8 under 35 U.S.C. 103

DeAngelis discloses a method and apparatus for forming books comprising pages of coated paper interspersed with pages of newsprint paper. DeAngelis teaches a printing apparatus having web roll stands 10, 12, 14 and 16; a perforating unit 18; printing units 20 and 22; a dryer or heatset unit 24; a folder 26; a trimmer 28; an interleaver 30; and a guide roller 40.

The Examiner states that the "guide roller 40 appears to have a diameter which is equal to the diameter of the printing rollers or cylinders 20a-20e as shown in Fig. 1 of DeAngelis." However, this feature is not disclosed or taught in DeAngelis, nor did the Examiner cite any support for it in the specification or the claims of DeAngelis. Applicant respectfully calls the Examiner's attention to a line of CAFC cases which consistently hold that "patent drawings do not generally define the precise proportions of the elements depicted therein and therefore may not generally be relied on to show particular sizes if the specification is completely silent on the issue." Hockerson-Halberstadt, Inc. v. Avia Group Int'l, Inc., 222 F.3d 951, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000) (citing In re Wright, 569 F.2d 1124, 1127, 193 USPQ 332, 335 (C.C.P.A. 1977) ("Absent any written description in the specification of quantitative values, arguments based on measurement of a drawing are of little value."); In re Olson, 212 F.2d 590, 592, 101 USPQ 401, 402 (C.C.P.A. 1954)). In fact, DeAngelis does not mention the diameter of the roller 40 at all. Therefore, DeAngelis fails to disclose or teach a guide roller having a diameter that is equal to, or an integral multiple of, a diameter of a printing cylinder in the printing unit, as recited in independent claim 8.

In addition to the above distinctive feature of the present invention, the Examiner concedes that DeAngelis fails to "clearly teach the guide roller which is rotated synchronously at the identical peripheral speed with the printing cylinder." The Examiner attempts to bridge this gap by applying Loiacono. However, as explained below, Loiacono fails to disclose the subject matter of the present invention missing from DeAngelis

Loiacono teaches a paper tinting and drying machine having a tinting module and a dryer module spaced apart from one another by a predetermined distance so that aqueous liquid ink with less than five percent volatile organic compounds by volume applied to the underside of the paper can be visually inspected by the machine operator and so that ink application adjustments located on

the paper output side of the tinter module can be accessed by the machine operator. In short, the object of Loiacono is to prevent paper from curling and stretching. The speed of the drive rollers is determined by a machine operator control adjustment in one embodiment. In another embodiment, the speed of rotation of a take-up device is monitored by a tachometer which controls the speed of travel of the paper through the tinter module. Accordingly, in Loiacono, the rollers 28 and 30 disposed between the tinter-coater module 15 and the tinter-coater dryer assembly 14 are merely passive idler rollers which are not driven by a drive unit (Loiacono, Fig. 3 and 4, col. 6, lines 47-52 and 61-65).

As stated in the Office Action, Loiacono merely teaches a "conventional use of a controlling means for regulating the speed of the take-up means..." The Examiner contends that with Loiacono "the guide roller can be synchronously rotated at the same peripheral speed of the prining cylinder." However, as pointed above, Loiacono's guide rollers are NOT driven. Moreover, there is no teaching in either DeAngelis or Loiacono to drive the guide roller at such a peripheral speed. Furthermore, there is no viable motivation provided by the Examiner to drive the guide roller at such a peripheral speed. The fact that something "can" be done is an insufficient basis to obviate an invention. Absent such motivation, the references can be revised and/or combined in the manner suggested by the Examiner only with impermissible hindsight based on the present invention.

A person of ordinary skilled in the art would have no motivation to combine DeAngelis with Loiacono in the way proposed in the Office Action. The Examiner's statement that "modifying the press of DeAngelis by providing the controlling means as taught by Loiacono to permit more precise control..." is mere conjecture. The reason for combining the various claimed features of the present invention is because of the above-mentioned problem it addresses which is caused by undried printing ink on a paper surface that may come into contact with a guide roller which might

then transfer back to another paper surface, thereby contaminating the printed paper or print. Such a problem has not been recognized, let alone addressed, by the applied references.

Recognition of the problem being solved is important when considering the issue of obviousness under 35 USC 103. There is a line of CAFC cases dealing with the relevance of the problem being solved in determining obviousness. In re Dillon, 892 F.2d 1554 (Fed. Cir. 1989). In re Wright, 848 F.2d 1216 (Fed. Cir. 1988) states the following:

"The determination of whether a novel structure is or is not 'obvious' requires cognizance of the properties of that structure and the problem which it solves, viewed in light of the teachings of the prior art." (emphasis added).

It is respectfully submitted that this aspect of the case law has not been considered in formulating the obviousness rejection. Its fair applicability must lead to a conclusion of unobviousness of the invention over the applied references.

For all the reasons given above, independent claim 8 is patentable over DeAngelis and Loiacono when applied singly or in combination.

Patentability of the Dependent Claims

Dependent claim 9 recites paper feeders disposed substantially in a direction in which the webs are supplied individually therefrom and the printing units are disposed in line substantially in a direction in which the webs from the paper feeders travel individually whereby the webs are printed in parallel with one another, and the printed webs are then dried and thereafter placed one on top of another to form a product. Further, one web printed through one printing unit that is disposed farthest downstream is passed directly into the drier and each of the other webs printed

by the other printing units respectively is guided by the guide roller that is disposed downstream of each of the other printing units so as to bypass those printing units located downstream respectively and then to travel into the dryer. Neither DeAngelis nor Loiacono teaches such an arrangement. Therefore, dependent claim 9 is patentable over DeAngelis and Loiacono for these additional reasons.

Each of claims 9-14 depends from allowable independent claims 8 and, thus, benefits from the allowability thereof.

Conclusion

Based on all the above, it is respectfully submitted that the present application is now in proper condition for allowance. Prompt and favorable action to this effect and early passing of this application to issue are respectfully solicited.

Should the Examiner have any comments, questions, suggestions or objections, the Examiner is respectfully requested to telephone the undersigned in order to facilitate reaching a resolution of any outstanding issues.

It is believed that no additional fees or charges are required at this time in connection with the present application. However, if any such fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,
COHEN, PONTANI, LIEBERMAN & PAVANE

By Thomas Langer
Thomas Langer
Reg. No. 27,264
551 Fifth Avenue, Suite 1210
New York, New York 10176
(212) 687-2770

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